

REMARKS/ARGUMENTS

In this response, no claims have been added or canceled. Claims 1-45 remain pending in this application.

Claim Objections

Claims 37-42 are objected to because of certain informalities. Specifically, the Examiner suggests that the claim language “machine” be changed to “computer.” The Examiner further suggests that the preamble for claims 37 and 40 be rewritten to:

“A computer readable medium having executable instructions to perform operations including:”

(emphasis added). Applicants respectfully traverse.

The Examiner has not indicated a reason for the objection and Applicants submit that the use of the term “machine” is not objectionable. It is well established that a computer or other programmable apparatus whose actions are directed by a computer program or other form of “software” is a statutory “machine.” Thus, the basis for these computers or programmable apparatus as configured being statutory is that they *are* “machines.” As the Examiner is well aware, the Examination Guidelines of the Office state:

USPTO personnel should begin claim analysis by identifying and evaluating each claim limitation. ... For products, the claim limitations will define discrete physical structures or materials. Product claims are claims that are directed to either machines, manufactures or compositions of matter.

Section II.C., Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility, United States Patent and Trademark Office OG Notices: 22 November 2005 (emphasis added). In fact, in numerous parts of the examples provided by the Office directed to

the examination for computer-related inventions, one of the inquiries is whether the claimed invention a specific “machine” or “manufacture”? See, e.g., Q.10., Examination Guidelines for Computer-Related Inventions-Training Materials Directed to Business, Artificial Intelligence, and Mathematical Processing Applications,

<http://www.uspto.gov/web/offices/pac/compexam/comguide.htm> (emphasis added)

Applicants request that the Examiner withdraw these objections or, in the alternative, provide specific reasons for the objections by citing a specific section under the Code, Rules or MPEP that references a rule or law, such as under MPEP 608.01, Form of the Claims.

Claim Rejections – 35 USC § 102(e)

Claims 1-45 are rejected under 35 USC § 102(e), as being anticipated by Chen et al (U.S. Patent Publication No. US 2005/0208959).

The Examiner has noted that the applied reference has a common assignee with the instant application. Further, based upon the earlier reference, it constitutes prior art under 35 U.S.C. 102(e). The Examiner stated that this rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and it is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

Applicants respectfully submit that Chen, filed on July 14, 2004, and assigned U.S. Pat. App. Serial No. 10/889,926 (the ‘926 application), is disqualified under 35 USC § 102(e) because it was, at the time the invention of the present application (U.S. Pat. App. Serial No. 10/725,904—the ‘904 application) was made, subject to an obligation of assignment to the same entity. Specifically, U.S. Pat. App. Serial No. 10/889,926 and U.S. Pat. App. Serial No. 10/725,904 were, at the time the invention of U.S. Pat. App. Serial No. 10/889,926 was made, subject to an obligation of assignment to QUALCOMM Incorporated (QUALCOMM). Assignments evidencing the ownership of QUALCOMM for the ‘926 and the ‘904 applications were recorded at Reel/Frame: 016218/0355 on May 13, 2005, and Reel/Frame: 014759/0712 on December 1, 2003, respectively. A declaration under 37 CFR 1.132 is submitted herewith.

Thus, as Chen is disqualified as prior art, Applicants request that the rejections to these claims be withdrawn.

Further, it is respectfully submitted that Applicants do not agree with the Examiner regarding the conclusions reached by the Examiner's analysis, and that Applicants are not commenting on the technical merits of the rejection, as it has been addressed by the declaration submitted by Applicants under 37 CFR 1.132.

CONCLUSION

Therefore, for at least the reasons presented above with respect to all of the pending claims subsequent to entry of this response, Applicants assert that all claims are patentably distinct from all of the art of record. All objections and rejections having been addressed, it is respectfully submitted that this application is in condition for allowance and a Notice to that effect is earnestly solicited. If any points remain in issue that the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Please charge any fees or overpayments that may be due with this response to Deposit Account No. 17-0026.

Respectfully submitted,
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